UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,822	04/05/1999	THOMAS A. GRATE	MS1-305US	5476

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EXAMINER
BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 March 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 April 1999</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 1-39 are currently pending in the application.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3.   Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,052,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broad enough to encompass the subject matter claimed in U.S. Patent No. 6,052,710.

Specification

4.   The use of the trademark Microsoft Corporation has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any manner

which might adversely affect their validity as trademarks.

Drawings

5.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the process of automatically

configuring a new trading relationship with a new trading partner using configuration details

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office

action to avoid abandonment of the application. The objection to the drawings will not be held

in abeyance.

Request for Information

6.   Applicant and the assignee of this application are required under 37 CFR 1.105 to

provide the following information that the examiner has determined is reasonably necessary to

the examination of this application.

7.   It is requested that information be provided regarding the Internet Information Server

from Microsoft Corporation, the Site Server, Commerce Edition, from Microsoft Corporation,

Mircrosoft's Commerce Interchange Pipeline, and Microsoft's Commerce Interchange Pipeline

Manager. All of these products are mentioned but in no way described on page 4 of the

applicant's specification. The working details of these products are not well known. All

information regarding the features, operation, use, distribution, and sale of these products is requested.

8.   The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

9.   This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Rejections - 35 USC § 112

10.   Claims 1, 4, 8, 10, 15, 22, 27, 28, 29, 30, 33, and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicants' invention is directed to an automated configuration process that involves two phases. The first phase involves a conventional manner for publishing information to a web site. The first phase for publishing information to a web site is entirely well known in the art and

numerous references cited by the examiner in previous office actions show such a feature. The

second phase of the applicant's invention involves automatically creating and configuring a

trading relationship for online exchanges with a potential trading partner. There is no disclosure

in the applicant's specification that provides a means for fulfilling the enablement requirement

with regard to automatically creating and configuring a new trading relationship. Page 10, lines

13-19 of the applicant's specification merely state that a trading partner record is created and

automatically populated. Such a vague disclosure fails to put the public in possession of the

invention.

The requirement for an adequate disclosure ensures that the public receives something in

return for the exclusionary rights that are granted to the inventor by a patent. The grant of a

patent helps to foster and enhance the development and disclosure of new ideas and the

advancement of scientific knowledge (See M.P.E.P. Section 2162). There is nothing in the

applicant's specification that helps to foster and enhance the development and disclosure of new

ideas and the advancement of scientific knowledge. Rather there is at best an abstract discussion

of creating a trading relationship.

There is nothing within the applicant's specification that provides any guidance for one

skilled in art to create a system for automatically creating a trading relationship, placing an undo

burden of experimentation on anyone trying to implement the applicants claimed invention. For

instance, there is no definition as to what a trading relationship is in the context of the applicant's

invention. A person skilled in the art would have to figure out what defines a trading

relationship, how funds are transferred, and what defines a trade. There are no details provided

on how the first trading partners computer interfaces the second trading partner's computer to

"automatically" create and configure a trading relationship. A person skilled in the art would

have to figure out how to access get the first trading partners computer to access the second

trading partner's web site and retrieve configuration details and once the details were obtained

there is no guidance for how to make the first trading partners computer interface the second

trading partner's computer, establishing the trading relationship.

In summary, the applicant's specification states that "the process is advantageous over

prior art systems in that the trading relationships are established automatically" (page 10, lines

20-21). However, the applicant's specification fails to provide any direction for one try to

implement a system establishing a trading relationship automatically.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claims 1, 3, 8, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Number 5,812,669 to Jenkins et al..

13.   As to claim 1, Jenkins teaches a method for establishing a trading relationship between

trading partners involved in electronic commerce, the method comprising: retrieving

configuration details associated with a potential trading partner from a remote site (col. 6, lines

4-42); and automatically configuring a trading relationship with the potential trading partner

using the configuration details (col. 5, lines 40-67); however Jenkins does not explicitly teach establishing a relationship with a new trading partner.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Jenkins regarding the establishment of a trading relationship with the idea of trading with a new partner because at some point in time any trading partner has to be new.

14.   As to claim 3, Jenkins teaches a method as recited in claim 1, wherein the automatically configuring comprises: creating a trading partner record (col. 6, lines 4-42); and automatically populating the trading partner record with the configuration details (col. 6, lines 4-42).

15.   As to claim 8, claim 8 features the same limitations as claims 1 and 3 combined and is thus rejected on the same basis as claims 1 and 3.

16.   As to claim 30, Jenkins teaches a method for establishing a trading relationship between trading partners involved in electronic commerce, the method comprising: retrieving configuration details associated with a first potential trading partner from a remote site by a second potential trading partner (col. 5, lines 40-67); retrieving configuration details associated with the second potential trading partner from a remote site by the first potential trading partner (col. 5, lines 40-67); and automatically configuring a trading relationship with the first and the second potential trading partners using the configuration details (col. 6, lines 4-42); however Jenkins does not explicitly teach establishing a relationship with a new trading partner.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Jenkins regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

17.   As to claim 32, Jenkins teaches method as recited in claim 30, wherein the automatically

configuring comprises: creating a trading partner record; and automatically populating the

trading partner record with the configuration details (col. 6, lines 4-42).

18.   Claims 1-11, 13-17, and 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent Number 6,490,567 to Gregory.

19.   As to claim 1, Gregory teaches a method for establishing a trading relationship between

trading partners involved in electronic commerce, the method comprising: retrieving

configuration details associated with a potential trading partner from a remote site (col. 8, lines

36-52); and automatically configuring a trading relationship with the potential trading partner

using the configuration details (col. 8, lines 53-67); however Gregory does not explicitly teach

establishing a relationship with a new trading partner.

     It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Gregory regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

20.   As to claim 2, Gregory teaches a method as recited in claim 1, wherein the retrieving

comprises addressing a URL to access the configuration details.

21.   As to claim 3, Gregory teaches a method as recited in claim 1, wherein the automatically

configuring comprises: creating a trading partner record (col. 11, lines 13-25); and automatically

populating the trading partner record with the configuration details (col. 11, lines 13-25).

22.   As to claim 4, Gregory teaches an electronic commerce trading system involving

exchanges of commerce information over a network, a method comprising: collecting

configuration details associated with a trading partner participating in the commerce trading

system (col. 6, lines 37-54); and publishing the configuration details to a Web site (col. 8, lines

26-35); however Gregory does not explicitly teach establishing a relationship with a new trading

partner.

It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Gregory regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

23.   As to claim 5, Gregory teaches a method as recited in claim 4, wherein collecting

comprises presenting a graphical user interface to enable a user to enter the configuration details

(col. 6, lines 37-54).

24.   As to claims 6, 9, 13, 14, 19, 20, 24, 25, 31, 37, and 38, claims 6, 9, 13, 14, 19, 20, 24,

25, 31, 37, and 38 are anticipated by Gregory for the same reasons discussed in the rejection of

claim 2.

25.   As to claim 7, Gregory teaches a method as recited in claim 4, wherein the Web site is

associated with the trading partner (col. 8, lines 26-35).

26.   As to claim 8, claim 8 features the same limitations as claims 1 and 3 combined and is

thus rejected on the same basis as claims 1 and 3.

27.   As to claim 10, claim 10 has the similar limitations as claims 4 and 8 combined and is

thus rejected on the same basis as claims 4 and 8.

28.   As to claims 11, 17, 23, and 34, claims 11, 17, 23, and 34 are anticipated by Gregory for

the same reasons discussed in the rejection of claim 5.

29.   As to claim 15, Gregory teaches a system comprising: a first computer system at a first

trading partner; a second computer system at a second trading partner; a Web site (col. 8, lines

12-67); the first computer system collecting configuration details associated with the first trading

partner and publish the configuration details to the Web site (col. 6, lines 37-54); and the second

computer system retrieving the configuration details from the Web site and automatically

configure for a trading relationship with the first trading partner using the configuration details

(col. 8, lines 10-67); however Gregory does not explicitly teach establishing a relationship with a

new trading partner.

     It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Gregory regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

30.   As to claim 16, Gregory teaches a system as recited in claim 15, wherein the first

computer system hosts the Web site (col. 8, lines 26-35).

31.   As to claims 21 and 26, they have similar limitations to claim 3 and are thus rejected on

the basis as claim 3.

32.   As to claims 22 and 27, they have similar limitations to claim 15 and are thus rejected on

the same basis as claim 15.

33.   As to claims 28 and 29, the limitations for claims 28 and 29 are included in claim 27.

Therefore, the same rejection applies.

34.   Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Number 6,490,567 to Gregory in view of U.S. Patent Number 6,466,940 to Mills.

35.   As to claim 12, Gregory teaches a method of publishing configuration details; however

Gregory does not teach the use of an XML format to publish the details.

        Mills teaches the publishing of trading configuration details in an XML format (col. 16,

lines 13-55 and col. 17, lines 1-10).

        It would have been obvious to one of ordinary skill in the Information Technology art at

the time of the invention to combine the teachings of Gregory regarding a trading system with

Mills regarding an XML display format because XML provides more extensibility than other

display formats.

36.   As to claim 18, it is rendered obvious by the Gregory-Mills combination for the same

reasons discussed in the rejection of claim 12.

37.   Claims 31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Number 5,812,669 to Jenkins et al. in view of U.S. Patent Number 6,490,567 to Gregory.

38.   As to claim 31, Jenkins teaches the method of claim 30, however Jenkins does not teach

the use of a URL for accessing configuration details.

        Gregory teaches a method wherein retrieving configuration details comprises addressing

a URL to access the configuration details of trading partners (col. 8, lines 26-35).

        It would have been obvious to one of ordinary skill in the Computer Networking art to

combine the teachings of Jenkins regarding the configuration of a trading relationship with the

teachings of Gregory regarding accessing a URL to retrieve trading configuration details because

a URL allows a conventional browser to access the details.

39.   As to claim 33, Jenkins teaches a method for establishing a trading relationship between

first and second trading partners involved in electronic commerce, the method comprising:

collecting first and second configuration details associated with the first and the second trading

partners, respectively (col. 20, lines 10-48); publishing the first and second configuration details

(col. 20, lines 49-65); creating, at the second trading partner, a trading partner record for the first

trading partner (col. 20, lines 10-48); creating at the first trading partner, a trading partner record

for the second trading partner (col. 20, lines 10-48); retrieving the configuration details

associated with the first trading partner (col. 20, lines 10-65); retrieving the configuration details

associated with the second trading partner (col. 20, lines 10-65); populating the trading partner

record of the second trading partner with the configuration details associated with the first

trading partner (col. 6, lines 4-42); and populating the trading partner record of the first trading

partner with the configuration details associated with the second trading partner (col. 6, lines 4-

42); however Jenkins does not explicitly teach the use of a Web site to publish and retrieve

configuration details or that a trading partner is new.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a

trade relationship (col. 8, lines 26-35).

It would have been obvious to one of ordinary skill in the Computer Networking art to

combine the teachings of Jenkins regarding the configuration of a trading relationship with the

teachings of Gregory regarding the use of a Web site for accessing configuration details because

a Web site allows a conventional browser to access the details.

It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Jenkins regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

40.   As to claim 34, Gregory teaches a method wherein collecting comprises presenting a

graphical user interface to enable a user to enter the configuration details.

41.   As to claim 35, it is rendered obvious by the Jenkins-Gregory for the same reasons

discussed in the rejection of claim 12.

42.   As to claim 36, Jenkins teaches a method wherein publishing comprises the first

configuration details at a first site associated with the first trading partner and the second

configuration details at a second site associated with the second trading partner (col. 20, lines 10-

65); however Jenkins does not explicitly teach the use of a Web site to publish and retrieve

configuration details.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a

trade relationship (col. 8, lines 26-35).

For discussed in the rejection of claim 33 it would be have been obvious at the time of the

invention to combine Jenkins with Gregory.

43.   As to claims 37 and 38, Gregory teaches publishing configuration details to a URL and

retrieving configuration details from the URL.

44.   As to claim 39, Jenkins teaches a first computer system at a first trading partner; a second

computer system at a second trading partner (col. 20, lines 10-65); the first computer system

collecting first configuration details associated with the first trading partner and publishing the

configuration details to a first site (col. 20, lines 10-65); the second computer system collecting

second configuration details associated with the second trading partner and publishing the

configuration details to a second site (col. 20, lines 10-65); the first computer system retrieving

the second configuration details from the second site and automatically configuring for a trading

relationship with the first trading partner using the second configuration details (col. 6, lines 4-

42); and the second computer system retrieving the first configuration details from the first site

and automatically configuration for a trading relationship with the first trading partner using the

first configuration details (col. 6, lines 4-42); however Jenkins does not explicitly teach the use

of a Web site to publish and retrieve configuration details or that a trading partner is new.

Gregory teaches the use of a Web site to publish and retrieve configuration details for a

trade relationship (col. 6, lines 37-54).

For discussed in the rejection of claim 33 it would be have been obvious at the time of the

invention to combine Jenkins with Gregory.

It would have been obvious to one of ordinary skill in the Computer Networking art at the

time of the invention to combine the teachings of Jenkins regarding the establishment of a

trading relationship with the idea of trading with a new partner because at some point in time any

trading partner has to be new.

Conclusion

45.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The

examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9306 for regular

communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
April 21, 2004

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER